

Applicants file this RCE in order to hold an interview with the Examiner on this case at the earliest convenience of the Examiner.

Applicants have reviewed the Examiner's comments in the Advisory Action of April 3, 2007, and respectively submit that the Examiner has failed to consider the limitation "wherein the metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a *boiling silver nitrate* solution is titrated with a sodium citrate solution to produce the silver colloid" in claim 1. Paragraph [0018] of the specification clarifies that "[t]he methods of producing metallic colloids described herein are in contrast to prior methods wherein a *boiling silver nitrate* is titrated with a sodium citrate solution."

The Examiner states in the Advisory that “McCormick teaches the organic molecule of the instant specification and the combination of Kidwell and McCormick teach the molecule attached to the metallic colloid particle. Therefore, the enhancement property is inherent to the colloid *produced by the combination of references.*” [Emphasis added.]

In the pending case, the Examiner is assuming that “wherein the metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a boiling silver nitrate solution is titrated with a sodium citrate solution to produce the silver colloid” is somehow “inherent” in a hypothetical embodiment arrived at by combining Kidwell and McCormick. However, “[o]bviousness cannot be predicated on what is not known at the time of an invention is made, even if the inherency of a certain feature is later established.” *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). The Board in *Rijckaert* did the same what the Examiner is doing, and the Federal Circuit reversed:

The Board concluded that the subject matter of the claims would have been obvious over Awamoto in view of Driessen, stating that “the time expansion or time compression relationship is satisfied for the

expansion of two disclosed [in] Awamoto when a wrapping angle of 360 degrees, one pair of heads and no non-recording intervals are assumed." The Board further asserted that the recognition of the claimed relationship between time expansion/compression and the three variables a , n , and M is "the mere discovery of a relationship that is applicable to [a] prior art apparatus[, and] does not [give] rise to a patentable invention." Thus, in affirming the rejection, the Board first assumed that the claim limitation at issue, the relationship between time expansion/compression and the three variables, was somehow "inherent" in the prior art as shown by Awamoto. The Board also assumed specific values for the claimed variables in order to assert that Awamoto's device satisfies the claimed relationship.

Rijckaert argues that the examiner has not established a prima facie case of obviousness and that the examiner's assumptions do not constitute the disclosure of prior art. We agree. Awamoto does not disclose the wrapping angle of the record carrier around the head drum or the number of times that a head pair which comes in contact with the record carrier does not record a signal on the record carrier. Nor does Awamoto discuss the claimed relationship of the three variables to time expansion/compression. Driessen, the secondary reference, is relied upon only to teach the provision of a pair of write heads having a mechanically rigid coupling to each other and does not remedy the deficiencies of Awamoto. Thus, the prior art relied upon does not disclose, suggest, or render obvious the claimed invention, either individually or when combined.

Awamoto does not describe the use of time expansion and compression as a means of optimally filling tracks, much less suggest that the three variables of the claims are even a factor in determining the amount of time expansion or time compression. Rather, Awamoto is concerned primarily with processing a high-quality broadcast television signal for use in conventional video machinery, and with compensating for errors introduced to such a signal by a transfer circuit. The Commissioner's assertion "that the [analysis discussed in his brief] and Awamoto demonstrate that the relationship was, in fact, well known in the art" is unavailing. While the court appreciates the Commissioner's thorough explanation of the claimed relationship in his brief, the Commissioner's brief is not prior art. The prior art is Awamoto, and it does not indicate that the relationship is well known

in the art, nor does it suggest the claimed relationship. See *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference).

To support the Board's affirmance of the rejection, the Commissioner points out that in the recording art, the exact matching of signal time to recording time is an optimal [*1534] condition, and that this condition would be met by fulfilling the claimed relationship. While the condition described may be an optimal one, it is not "inherent" in Awamoto. Nor are the means to achieve this optimal condition disclosed by Awamoto, explicitly or implicitly. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 53 C.C.P.A. 1375, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Rijckaert at 1533-34.

Nobody prior to this invention had established that the metallic colloids produced by the method of this invention had the property "wherein the metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a boiling silver nitrate solution is titrated with a sodium citrate solution to produce the silver colloid" as recited in claim 1. Thus, under the decision of the Federal Circuit in *Rijckaert*, it would not be correct to assert obviousness *in hindsight* gained from this invention and *based on* "the combination of references" (Kidwell and McCormick; see Advisory Action), as "[o]bviousness *cannot* be predicated on what is not known at the time of an invention is made, even if the inherency of a certain feature is later established." *Id.*; emphasis added.

Applicants further respectively submit that by arguing inherency based on “the combination of references” (see Advisory Action), the Examiner is taking a retrospective view on inherency, which is not permissible. “[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination.” *In re Newell*, 891 F.2d 899, 12 USPQ2d 1248 (Fed. Cir. 1989), cert. denied, 493 U.S. 814 (1989). *In Newell*, the Federal Circuit reversed an obviousness rejection of a particular claimed combination when the prior art did not disclose or suggest the function of the claimed function even though the prior art did disclose the various elements of the claimed combination.

The Board held that Newell had simply combined various elements of known tape drives, and that it would have been obvious to do so because it was “a mere substitution of one conventional tape capstan drive for another”. Newell argues, however, that the elements of the prior art are not simply physically combined and that his indirect power transfer from the power belt through the capstan to the drive belt is not shown or fairly suggested in the prior art.

Newell correctly states that the roller in the Weiss reference does not have a power transfer function. Newell also states, and the Solicitor does not dispute, that his new drive system achieves significantly enhanced power transmission to the tape, as compared with the prior art. Although the Solicitor argues that it is inherent that a belt drive will provide greater surface contact with the cartridge capstan, and thus better power transfer, a retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination.

Newell at 901.

In the pending case, the Examiner making the same mistake as that made by the Solicitor in *Newell*. In particular, the Examiner in the pending case is arguing that the Applicants have simply combined various elements from the prior art and therefore the limitation “wherein the

metallic colloid has a Raman signal that is greater than that of a silver colloid prepared by a titration method wherein a boiling silver nitrate solution is titrated with a sodium citrate solution to produce the silver colloid” in claim” is somehow “inherent” in a hypothetical embodiment arrived by combining elements of the prior art. This argument of the Examiner amounts to a *retrospective view of inherency*, which not a legal basis to assert inherency, as explained in *In re Newell*.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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